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EXAMINER

MOONEYHAM, JANICE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,697

Applicant(s)

LOWRANCE ET AL.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on April 20, 2001.

Claims 1-40 are pending in this application.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The applicant's abstract appears to be over 50 to 150 words.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 20, 39, and 40, the applicant identifies the invention in the preamble as being a system and method for generating and accessing arguments. However, the claim language never generates or assesses an argument. The applicant's method claims only the steps of searching templates and answering questions. It appears that applicant's invention is a decision

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processing system and method for facilitating decision making as stated on page 1, lines 17-18 of the specification. Claims 2-19 are dependent on claim 1, claims 21-38 are dependent on claim 20.

4. Claims 6 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear who generates the comments which are associated to the argument.

5. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

The applicant identifies the invention as a system. However, the only structure claimed is a database and a server. The applicant has not claimed the computer structure which is necessary for carrying out the invention.

6. Regarding claim 1, the phrase "which *may be* answered" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

7. Regarding claims 3 and 23, the phrase "*may be* automatically" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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8. Regarding claims 5 and 24, the phrase "*may be received*" render the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

9. Regarding claims 14 and 33, the phrase "*may be selected*" render the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 20-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

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In the present case, claims 20-38 only recite an abstract idea. The recited steps of merely searching a plurality of templates and answering questions does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user, by use of a pencil and paper, or manually. These steps only constitute an idea of how to access or generate an argument.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-8, 17-27, and 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Calver (US 2001/0032092) (hereinafter referred to as Calver).

Regarding Claim 1:

Calver discloses an analytical system for generating and accessing arguments (arguments are interpreted as being questions based on answers to previous questions) wherein each argument (question) has an associated conclusion as to whether a particular situation (product or service) will likely have a negative or positive result (information useful in determining whether service providers would (positive) or would not (negative) benefit the customer's business (page 7 [0082])), the analytical system comprising:

a database (Figure 2 (50) and page 11 [0127]) for storing a plurality of templates (Figure 4 (98), forms page 4 [0052], criteria Figure 14 (242)) that each include a plurality of questions

which may be answered to generate a particular argument (question based on answer) having an associated conclusion (solution/ recommendation) regarding a particular situation (product or service) that is based on answers to its associated template questions (Page 5 [0063] new questions based on previous answers); and

an server ((88) page 4 [0049-0051 and 0053], Figure 5)) for selecting one of the templates which is most relevant to a particular situation (process is generally driven by one or more questionnaires, each preferably followed by increasingly targeted information to match specific business interest (page 5 [0060]) and for receiving input to one or more of the selected template's questions to thereby generate a new argument (question based on answer) having an associated conclusion (solution/recommendation) based on such answers (page 5 [0063] new questions based on previous answers), the associated conclusion indicating whether the particular situation will likely have a positive or negative result (page 7 [0084])informing the customer whether services are beneficial to his or her business (positive); (information useful in determining whether service providers would (positive) or would not (negative) benefit the customer's business (page 7 [0082])).

The applicant is advised that Calver discloses a system with a database and a server. The intended use of the structure is generally given little patentable weight and thus does not distinguish the system from the prior art. An apparatus/system must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The database and server of Calver are fully capable of performing the functions as set forth in the claim language.

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Regarding Claim 20 and 39

Calver discloses a method and medium containing program instructions (software module page 9 [0100]) for accessing or generating an argument (questions based on previous answers) having a conclusion (solution) for a particular situation (web-based solutions page 4 [0054], provides products and solutions), the method comprising:

searching a plurality of templates (Figure 4 (98) filling out of forms (page 4 [0052]) /lead generation (page 5 [0060]) pre-qualifying templates (page 5 [0061], Figure 14 (242) criteria) for a relevant template most related to a particular situation (Figure 12 (214) industry/business/product information), wherein each template includes a plurality of questions (Figure 12 (216) general questions, page 5 [0060] questionnaires); and

answering one or more questions of the relevant template to form a new argument (question based on answer) having a conclusion (solution (page 4 [0054]) and resulting information (page 7 [0084]) informing customer of services by various providers and whether such services are beneficial to his or her business) based on the one or more answers (page 5 [0062-0062] The Product Configurator dynamically presents the user with new questions based on previous answers).

Regarding Claims 2 and 21:

Calver discloses a method and system further comprising associating supporting evidence to each answered template question (pages 7-8 [0084]- the customer can be additionally presented with the option to link pages containing product information from the respective providers. Such information may include....).

Regarding Claims 4 and 22:

Calver discloses a method and system further comprising associating a rationale to each answered template question (pages 7 [0074] industry specific information and resources).

Regarding Claims 3 and 23

Calver discloses a method and system wherein each template's questions are formed in a hierarchical structure, wherein a parent question that has a plurality of children questions may be automatically answered by answering the parent's children (The Product Configurator page 5 [0063] –contents of the Product Configurator can be modular, based on responses of the user to previous questions (parent). The Product Configurator dynamically presents the user with new questions (child) based on previous answers (parent))

Regarding Claims 5 and 24:

Calver discloses a method and system wherein input to one or more of the selected template's questions may be received from a plurality of users over a computer network (page 5 [0059] multiple user interactive sections, Figure 5).

Regarding Claims 6 and 25:

Calver discloses a method and system further comprising allowing one or more of the users to associate comments (recommendations) to at least a portion of the new argument (solution/product (Figure 8 (135-143), page 9 [0098] product and related recommendation).

Regarding Claims 7 and 26:

Calver discloses a method and system wherein the comments are only accessible by one or more specified users (Figure 8 9135-1430 and page 9 [0098]).

Regarding Claims 8 and 27:

Calver discloses a method and system wherein each template question is a multiple choice question (page 7 [0081] a graphically displayed drop down list or an actual number that is compared against *a list or ranges may be graphically displayed* (multiple choice) for the user, page 7 [0082] credit data can be entered by a graphically displayed check list (multiple choice), test entry box or drop down list (multiple choice).

Regarding Claims 17 and 36:

Calver discloses a method and system wherein one or more template questions have an associated discovery tool that facilitates answering of such associated template question (pages 7-8 [0084]- the customer can be additionally presented with the option to link pages containing product information from the respective providers. Such information may include, for example, case studies, testimonials, descriptions....and so forth.).

Regarding Claims 18 and 37:

Calver discloses a method and system wherein each template is associated with a situation descriptors (page 10 [0107] range of categories), the method and system further

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comprising selecting one of the templates which is most relevant to a particular situation by comparing a current situation to the situation descriptors associated with the templates to thereby find the most relevant templates having the most closely matching situation descriptors (page 10 [0107] applicant interested in Loans category will find products and services offered by financial providers, Credit category will offer products and services offered by credit providers).

Regarding Claims 19 and 38:

Calver discloses a method and system further comprising creating a new template, wherein the new template is created by an expert (.page 11 [0127] business rules – method and system make decisions and solves problems by using knowledge and rules defined by experts, ie business rules).

Regarding Claims 40:

Calver discloses a computer system operable to access or generate an argument (question based on answer) having a conclusion (solution/recommendation) for a particular situation (product or service), the computer system comprising:

one or more processors (Figure 2(31), page 3 [0040-0041]);

one or more memory (Figure 2 (50)) wherein at least one of the processors and memory are

adapted to:

search a plurality of templates for a relevant template most related to a particular situation, wherein each template includes a plurality of questions (Figure 16); and

answer one or more questions of the relevant template to form a new argument having a conclusion based on the one or more answers (new questions based on previous answers, page 5[0063]).

The applicant is advised that Calver discloses a system with processors and memory. The language “adapted for” is generally given little patentable weight in an apparatus/system and thus does not distinguish the system from the prior art. An apparatus/system must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The database and server of Calver are fully capable of performing the functions as set forth in the claim language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 9-16 and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over.

Calver (US 2001/0032092) (hereinafter referred to as Calver)

Regarding Claims 9-10 and 28-29:

Calver does not disclose a method and system wherein each multiple choice question asks to what degree of likelihood will a particular factor related to the particular situation have a positive or negative result or wherein each multiple choice question has a categorical scale of likelihood represented by a set of answers that partition the likelihood scale

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However, it is old and well known to ask provide preferences or degrees of likelihood in the form of multiple choice questions, such as, I agree, I agree somewhat, I disagree, I strongly disagree, It is unlikely, It is probable.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include multiple choice questions which ask to what degree of likelihood with a categorical scale of the likelihood that a particular factor related to a situation would have a positive or negative result since a skilled artisan would have recognized that this practice identifies more specifically what product or service would or would not be most beneficial to a customer's business, best suit the customer's needs and provide the greatest interest and utility to the user.

Regarding Claim 11 and 30:

Calver discloses a method and system wherein each template's questions are formed in a hierarchical structure, wherein a parent question that has a plurality of children questions may be automatically answered by answering the parent's children (The Product Configurator page 5 [0063] –contents of the Product Configurator can be modular, based on responses of the user to previous questions (parent). The Product Configurator dynamically presents the user with new questions (child) based on previous answers (parent))

Regarding Claims 12 and 31:

Calver discloses a method further comprising providing more than one answer for at least one question (Figure 10 (184-192), page 5 [0057] for the customer the system may provide

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access to multiple products through one point of contact; allows customers to answer basic questions about products and services)

Regarding Claims 13 and 32:

Calver discloses a method wherein the parent question is automatically answered using a answering technique selected by a user (portal functionality (multiple user interaction sections; page 6 [0069] – while viewing the web based portal homepage, the user may be faced with the option of directly filling out a Pre-Qualified Template questionnaire; page 6 [0070] Product Oriented – if the product orientation format is selected.... Figure 6 and descriptions on page 6 [0068])

Regarding Claims 14 and 33:

Calver discloses a method and system wherein the answering technique *may be* selected from a group consisting of a maximization technique, an averaging technique, and a minimization technique (maximization techniques - Figure 13 (236) Management Best Practices- Documentation regarding best practices in small businesses; page 12 {0133} .

Regarding Claims 15 and 34:

Calver does not disclose a method wherein each answer within the hierarchical structure has a color selected from a subset of colors, each color representing a different answer so that the hierarchical structure's colors convey a line of reasoning.

However, it would have been obvious to design a method and system with color since the color does not alter the steps of the method or the structure of the system and the invention would perform equally as well with or without color to convey a line or reasoning and a line of reasoning can be shown by using different fonts or any text format.

Regarding Claims 16 and 35:

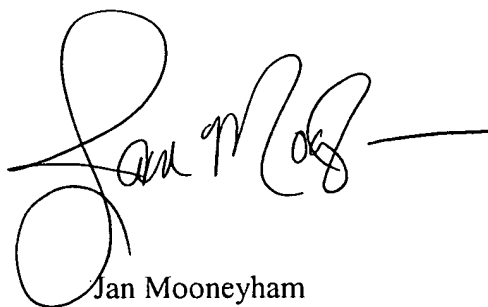
Calver discloses a method and system wherein one or more template questions is associated with a second hierarchical structure of questions and the first and second hierarchical structures together form a set of cascaded arguments (questions) (page 5 [0063] questions based upon answers to above questions).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a horizontal line extending to the right.

Jan Mooneyham
Patent Examiner
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